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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/539,641	06/16/2005	Charles C Hart	2836-USP-PC-T-US	6610
21378 7590 02/18/2009 APPLIED MEDICAL RESOURCES CORPORATION 22872 Avenida Empresa Rancho Santa Margarita, CA 92688				
EXAMINER RAMANA, ANURADHA				
ART UNIT 3775		PAPER NUMBER		
MAIL DATE 02/18/2009		DELIVERY MODE PAPER		

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

# Office Action Summary

**Application No.**

10/539,641

**Applicant(s)**

HART, CHARLES C

**Examiner**

Anu Ramana

**Art Unit**

3775

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 19 December 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-6 and 8-35 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-6 and 8-35 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-8508)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

## DETAILED ACTION

### *Claim Rejections - 35 USC § 102*

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-3, 6, 8 and 11 are rejected under 35 U.S.C. 102(b) as being anticipated by Tovey (US 5,333,624).

Tovey discloses a continuous ring member 22 with a surgical mesh or fabric or membrane 9 attached to a top surface of the ring member (Figs. 8, 9, 12 and 14, col. 5, lines 62-68, col. 6, lines 1-58, col. 7, lines 55-68 and col. 8, lines 1-14).

Claims 1-6, 8-9, 11 and 35 are rejected under 35 U.S.C. 102(b) as being anticipated by Boschetti (US 4,497,317).

Boschetti discloses a device including a malleable ring member 4 and a membrane or bag 2 fixedly attached to a perimeter of the ring member wherein the bag is made of a membrane of cotton, a bias woven fabric (Figs. 1, 3 and 4, col. 2, lines 65-68, col. 3 and col. 4, lines 1-63).

It is noted that a claim containing a "recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus" if the prior art apparatus teaches all the structural limitations of the claim. Ex parte Masham, 2 USPQ2d 1647 (Bd. Pat. App. & Inter. 1987).

Claims 1-6, 8, 19-20 and 26-29 are rejected under 35 U.S.C. 102(b) as being anticipated by Kindberg et al. (US 5,143,082), as evidenced by Ellman (US 4,428,375).

Kindberg et al. disclose a surgical device to temporarily reposition body tissues and organs including a ring member having cords 20 and a membrane 15 made of a flexible material that could be a mesh structure (Figs. 1-3, col. 2, lines 56-68, col. 3 and col. 4, lines 1-56).

Kindberg et al. refer to Ellman for examples of pliable surgical materials having a mesh structure. Ellman discloses a mesh construction with woven or knitted strands (see col. 2, lines 18-68 of Ellman).

The method steps of claim 26-29 are inherently performed when the Kindberg et al. device is used to reposition organs during a surgical procedure.

Claims 1, 3-6, 8-13, 26-27 and 29-31 are rejected under 35 U.S.C. 102(e) as being anticipated by Rambo (US 6,450,983).

Rambo discloses a retraction device with a malleable ring member 10 and a sleeve or membrane 8 attached to a perimeter of the ring wherein the membrane is made from an elastic material (Figs. 1, 6-9, 16, 18, 40-41, 63 and 66, col. 6, lines 3-67, cols. 7-8 and col. 9, lines 1-33).

Regarding the limitation, "positioned across the ring member," it is the Examiner's position that membrane 8 of Rambo covers the ring member and is thus positioned across the ring member, in that it extends from an inside surface of the ring member to the opposite, outside surface of the ring member.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claim 5 is rejected under 35 U.S.C. 103(a) as being unpatentable over Sienkiewicz (US 5,656,012) in view of Bonutti (US 5,163,949).

Sienkiewicz discloses all elements of the claimed invention except for the retractor being made of a transparent material.

It is well known in the art to construct a retractor of a transparent material for better visibility.

Accordingly, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have constructed the Sienkiewicz retractor of a transparent material, as taught by Bonutti, for better visibility.

Claims 2, 28 and 35 are rejected under 35 U.S.C. 103(a) as being unpatentable over Rambo (US 6,450,983) in view of Berman (US 5,899,942).

Rambo discloses all elements of the claimed invention except for a membrane made of bias woven or knitted fabric.

Berman teaches a medically acceptable barrier or membrane material made of a knit or woven polyester fabric (col. 3, lines 52-67 and col. 4, lines 1-12).

Accordingly, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have constructed membrane 8 of Rambo of a knit or woven polyester fabric, as taught by Berman, since it was well known in the art to use a woven polyester fabric as a medically acceptable material that is impermeable to tissue and debris.

Claims 14-25 and 32-34 are rejected under 35 U.S.C. 103(a) as being unpatentable over Rambo (US 6,450,983) in view of Balsells (US 5,161,806).

The combination of Rambo and Berman discloses all elements of the claimed invention except for a reinforcement member in the ring to adjust the flexibility of the ring.

It is well known to modify the flexibility of a hollow ring by reinforcing the ring using a metallic component (14) embedded in a plastic component as demonstrated by Balsells (col. 2, lines 1-12).

Accordingly it would have been obvious to one of ordinary skill in the art at the time the invention was made to have provided a selectively malleable ring in the device of Rambo by providing a hollow ring with reinforcement, as demonstrated by Balsells, since it was well known in the art to provide reinforcement in a hollow ring to change its malleability.

The method steps of claims 32-34 are rendered obvious by the above discussion.

### ***Response to Arguments***

Applicant's arguments have been fully considered.

Applicant's arguments with respect to Sienkiewicz are not persuasive because "continuous ring member" requires various elements of the ring member to be in immediate connection or spatial relationship. It is suggested that Applicant's better define the claimed invention over Sienkiewicz.

With regard to being "adapted to be twisted, folded, bent or deformed with respect to a plurality of bending axes," it has been held that the recitation that an element is adapted to perform a function is not a positive limitation but only requires the ability to so perform and does not constitute a limitation in any patentable sense. In re Hutchison, 69 USPQ 138.

Applicant's arguments with respect to Boschetti are not persuasive because Boschetti clearly discloses a continuous ring member and a membrane 2 attached to the inside or bottom surface of the membrane. It is the Examiner's position that membrane 2 is stretched across a portion of the ring member (Fig. 3).

Applicant's arguments with respect to Kindberg et al. are not persuasive because Kindberg et al. discloses a continuous ring member or part or portion of a ring wherein the ring is attached to a top surface of the membrane and at least a portion of the membrane is stretched across a portion of the ring (Fig. 3).

Applicant's arguments with respect to the rejections over Rambo are not persuasive because Rambo clearly discloses a continuous ring member attached to a top surface of a membrane 8. It is the Examiner's position that the membrane is stretched across a portion of the ring member (Figs. 6 and 7).

### ***Conclusion***

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Anu Ramana whose telephone number is (571) 272-4718. The examiner can normally be reached Monday through Friday between 8:00 am to 5:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eduardo Robert can be reached at (571) 272-4719. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

AR  
February 11, 2009

/Anu Ramana/  
Primary Examiner, Art Unit 3775